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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,322	04/12/2000	Albert L. Donaldson	110768-00102	6262
27557	7590	07/13/2006	EXAMINER	
BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037			WINDER, PATRICE L	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,322

Applicant(s)

DONALDSON, ALBERT L.

Examiner

Patrice Winder

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44,45,47-51,54-59,63-74 and 78-96 is/are pending in the application.
- 4a) Of the above claim(s) 47,48,51,54-57,63-72,78-85 and 91-96 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44,45,49-50,58-59,73-74,86-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Based on applicant's arguments filed on April 18, 2006 dependent claims 49 and 50 are rejoined to the elected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 44-45, 49-50, 58-59, and 73-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Leeds, USPN 6,393,465 (hereafter referred to as Leeds).
4. Regarding claims 44, 58 and 73, Leeds discloses system for selectively accepting an electronic message having a sender (column 6, lines 36-65), the comprising:

establishing a test connection to an authorized mailhost for the sender address (column 4, lines 37-59),

sending a recipient command specifying the sender address to authorized mailhost (column 5, line 63 - column 6, line 51), and

rejecting the electronic message if the authorized mailhost indicates that the sender address does not exist at the authorizing mailhost (column 8, lines 1-23).

5. Regarding claims 45, 59 and 74, Leeds further comprising accepting the electronic message if the authorized mailhost affirmatively accepts the recipient (column 5, lines 19-28).

6. Regarding dependent claim 49, Leeds taught the authorized mailhost is a mail exchanger host for the domain of the e-mail address (column 4, lines 2-6).

7. Regarding dependent claim 50, Leeds taught the at least one authorized mailhost has the same name as the domain of the sender address (column 4, lines 2-6).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 86-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds in view of Barchi, USPN 6,507,866 B1 (hereafter referred to as Barchi).

10. Regarding dependent claim 86, Leeds taught a test protocol involving a message (column 5, lines 21-23). Leeds does not specifically teach said recipient command is the Simple Mail Transfer Protocol (SMTP) RCPT command. Barchi taught recipient command is the Simple Mail Transfer Protocol (SMTP) RCPT command (column 1, lines 42-55). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made that incorporating Barchi's SMTP protocol in Leeds system for testing sender addresses would have expanded system utility. The motivation would have been use a standard protocol and promote greater system utility.

11. Regarding dependent claim 87, Barchi taught a SMTP MAIL command specifying a complete e-mail address (column 1, lines 42-55).

12. Regarding dependent claim 88, Barchi taught a SMTP command MAIL specifying the null address "<>" (part of protocol).

13. Regarding dependent claim 89, Barchi taught said rejection is made based upon the authorized mailhost's numeric response to the RCPT command (part of protocol to include a number with RCPT command).

14. Regarding dependent claim 90, Barchi taught said determination is made based upon the authorized mailhost's numeric response to a SMTP DATA command (part of protocol to include a number with DATA command).

Response to Arguments

15. Applicant's arguments filed April 18, 2006 have been fully considered but they are not persuasive.

16. Applicant argues - That Leeds does teach a RCPT command.

a. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., RCPT command of SMTP) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

b. Because SMTP is not specifically taught in the independent claims, the protocol is still a test protocol and the recipient command is not necessarily the RCPT command.

Conclusion


17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patrice Winder
Primary Examiner
Art Unit 2145

July 5, 2006